

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Ola OLOFSSON

Serial No.: 10/761,401

Filed: January 22, 2004

Confirmation: 3311

Group Art Unit: 3725

Examiner: SHELLY M.  
SELF

For: **PROCESS FOR MANUFACTURING OF JOINING PROFILES**

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

Applicants request review of the final rejections prior to filing a brief in this matter:

**THE INVENTION:**

There are several independent claims which are rejected as “anticipated” under 35 U.S.C. 102(b) over Moriau et al. (U.S. Patent 6,006,486). Among these independent claims are claims 28-31 and 33. In taking claim 29 as representative of the group the invention is directed to a floor formed of at least a first and second board, each of the boards have edge and the edge on the first board comprises a projecting tongue and the edge of the second board comprises a groove having a depression therein, wherein the depression is located distally of an innermost portion of the groove and furthermore “wherein at least

one of the tongue and the groove comprise a burr-free broached portion, such that the at least one of the tongue and the groove are shaped to form a locking joint.” As described in the specification, e.g., the first page, opening paragraph “it is however difficult to achieve complex cross-sections with undercuts with traditional milling, especially in narrow grooves. It is desirable to achieve a process where the tolerance play is good, undercut with sharper angles are possible to manufacture and where dust and particles from the milling isn’t obstructing the process.” Accordingly, as set forth in the second paragraph on page 1, the process includes the steps of “fine molding undercuts in at least the groove of the board by means of broaching utilizing at least one broaching tool”. A broaching tool for the tongue is shown, for example, in Fig. 5 and a broaching tool for the groove is shown, for example, in Fig. 6.

As can be appreciated by those skilled in the art “broaching” can be described as similar to an incremental slicing or planeing of the work by means of cutting edges on the broaching tool. Such cutting edges are illustrated in each of Figs. 5 and 6, and produce a cut surface which is different from a surface formed by a rotating cutting tool, i.e, milling.

**THE REJECTIONS:**

- (1) Claims 24-27-31 and 33 are rejected under 35 U.S.C.102(b) as being anticipated by Moriau et al.( U.S. Patent 6,006,486).
- (2) Claims 24,27-31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable of Moriau et al.
- (3) Claims 21-23, 25 and 34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Moriau et al. in view of Serino et al. (U.S. Patent 6,357,197).

**CONCISE STATEMENT OF ERRORS IN THE REJECTIONS AS FAILING TO  
APPLY THE APPROPRIATE LEGAL STANDARDS**

The legal standard for anticipation under section 102 is well established and the Office has promulgated instructions to the examining corp, for example, in MPEP Section 2131, which states “to anticipate a claim, the reference must teach every element of the claim” and continues “a claim is anticipated only if each and every element is set forth in the claim is found, either expressly or inherently described, in a single prior art reference citations (omitted)”.

The legal standard for obviousness under Section 103 (a) as been confirmed by the KSR decision as being the Graham v. John Deere test discussed below.

**THE MORIAU REFERENCE**

Moriau does not teach anything about “broaching” and thus describes no product such as a floor, comprised of first and second boards, wherein at least one of the first and second boards has a “broached portion”.

**SPECIFIC ARGUMENTS TO EACH REJECTION**

(1) The final rejection, as set forth on page 3 states “as to the recitation, “...the broached portion having angles sharper than possible by milling” (claim 28) this is treated as a product-by-process limitation as, the claim positively defines either the tongue or groove to have both milled and broached portions and the tongue and groove to form a joint (emphasis added)”.

Thus, although the Examiner notes the positive limitation of Applicant’s claims she elects to treat them, not as claim structure, but rather as “product-by-process limitations”.

This is an improper standard because, as noted hereinabove, each of independent claims 28-31 and 33, purportedly anticipated by Moriau et al under 35 U.S.C. 102 (b) is to a product, i.e., either a floor or flooring system and not to a process.

Applicants also remind the Office that the instant disclosure is directed to a person “having ordinary skill in the art” and not necessarily to a Patent Examiner who does not understand the surface structure of a work the surface of which having been broached, as compared to a surface structure which has been milled. Clearly, Moriau only teaches milling, never mentions broaching, and thus can not possibly act, either expressly or inherently described, as an anticipatory reference to the claimed subject matter. Because the Examiner cannot even appreciate the difference between the surface instantly claimed, and a surface such as formed by Moriau, she “presumes” that they do not positively define an end result in a product that is “different” (distinct) from the prior art. However, in order to constitute anticipation, the legal standard requires “identity”, not merely similarity. Thus, the Examiner’s position on anticipation is untenable in light of the present record.

(2) The alternative rejection of claims 24, 27-31 and 33 under 35 U.S.C. 130(a) as being unpatentable over Moriau et al. again are also based on the Examiner’s mischaracterization of the claimed limitations as “product-by-process” rather than the specific surface structure of the work as claimed in the independent claims. Accordingly, the Examiner never reaches the “obviousness” criteria recently articulated in KSR International Co V. Teleflex Inc., 127 S.Ct.1727 (2007), confirming the Graham analysis (Graham v. John Deere, 383 U.S.1(1966)) that “the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skilled in the art are resolved”. This is a requirement of Graham, adopted by an unanimous court in KSR, and completely ignored in the Examiner’s approach under the 35 U.S.C. 103(a) rejection set forth in the Final Rejection. Accordingly the entire premise of “obviousness” is not supported by the Examiner’s statement of the Rejection.

(3.) Lastly, claims 21-23, 25 and 34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Moriau et al. in view of Serino et al. (U.S. Patent 6,357,197). At least here, the Examiner admits that “Moriau does not disclose the tongue and groove comprise a

milled polymeric material” but continues that “Serino discloses the tongue and groove to comprise a polymeric material”. The citation of Serino is never mentioned to show broaching and thus, Serino does not correct the deficiencies of Moriau, in failing to teach the broach surface on the claimed boards, floors or systems, and thus, still fails to establish a prima facie case of obviousness because the Examiner has not complied with the KSR or Graham tests. As the Supreme Court stated in KSR “rejections on obviousness grounds cannot be sustained by mere conclusory statements, instead there must some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”.

#### SUMMARY

Accordingly, Applicant respectfully submits that the Board cannot possibly sustain a rejection of anticipation when the Examiner does not even attempt to cite to the teaching of the reference to support the alleged anticipatory teachings.

Alternatively, when the Examiner fails to follow the three step Graham test and does not even note the differences between the prior art and the claimed invention the rejection of obviousness based on Moriau et al. alone cannot stand.

Lastly, while the Examiner finally recognizes the Moriau et al. deficiencies and cites Serino as allegedly curing such deficiencies, those deficiencies are only to the recitations of the dependent claims and not to the recitations of the independent claims, the deficiencies with regards to the anticipation and obviousness issues over Moriau et al. alone being noted above.

For the forgoing reasons a reversal of the Examiner’s decision is respectfully requested.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 14-1437, under Order No. 8688.019.USDV00.

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Respectfully submitted,



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